Docket No.: A-3754

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

By: _____ Date: October 13, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applic. No.	:	10/612,352	Confirmation No.: 3160
Inventor	:	Thomas Dera, et al.	
Filed	:	July 2, 2003	
Title	:	Method and Device for Rotary Processing of Materials	
TC/A.U.	:	3724	
Examiner	:	Charles Goodman	
Customer No.:		**24131**	

PETITION UNDER 37 C.F.R. 1.8(b)

Hon. Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

The facts leading to this petition are as follows:

Applicants received a *Notice of Abandonment* dated October 6, 2005, in the above-identified application. According to the notice, a copy of which is enclosed herewith, applicants had allegedly not responded to the Office action mailed January 12, 2005.

Applicants did indeed respond in the form of an amendment, which was facsimile-transmitted to the Patent Office on April 12, 2005 in accordance with Rule 1.6(d).

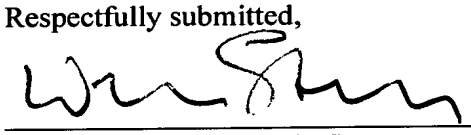
Enclosed herewith, in accordance with Rule 1.8(b), is a copy of:

- the amendment
- the transmission report showing that the amendment was received in the Patent Office on April 12, 2005

- the pertinent page of the outgoing mail log of April 12, 2005
- a declaration by Yonghong Chen, who signed the certification of facsimile transmission

Applicants respectfully request that the *Notice of Abandonment* be rescinded and that the application be restored to pending status.

Respectfully submitted,



Werner H. Stemer (34,956)

Date: October 13, 2005

Lerner and Greenberg, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101
/bb

Docket No.: A-3754

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Thomas Dera, et al.
Applic. No.	:	10/612,352
Filed	:	July 2, 2003
Title	:	Method and Device for Rotary Processing of Materials
Examiner	:	Charles Goodman - Art Unit: 3724

DECLARATION
TO ACCOMPANY PETITION UNDER 37 C.F.R. 1.8(b)

I, Yonghong Chen, hereby declare that:

- I have first-hand knowledge that the enclosed mailing was faxed to the Patent and Trademark Office on the date shown
- I personally signed the mailing certificate
- I have reviewed the outgoing mail log for April 12, 2005, and the pertinent page shows that the amendment was indeed facsimile-transmitted to the Patent Office on that date.

Yonghong Chen

Yonghong Chen

Date: October 13, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,352	07/02/2003	Thomas Dera	A03754	3160

24131 7590 10/06/2005

LERNER AND GREENBERG, PA
P O BOX 2480
HOLLYWOOD, FL 33022-2480

EXAMINER	
GOODMAN, CHARLES	
ART UNIT	PAPER NUMBER
3724	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of Abandonment

Application No.	Applicant(s)	
10/612,352	DERA ET AL.	
Examiner	**Art Unit**	
Charles Goodman	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on *12 January 2005*.
   (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
   (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
   (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
   (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
   (d) ☒ No reply has been received.

2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
   (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
   (b) ☐ The submitted fee of $_____ is insufficient. A balance of $_____ is due.
   The issue fee required by 37 CFR 1.18 is $_____. The publication fee, if required by 37 CFR 1.18(d), is $_____.
   (c) ☐ The issue fee and publication fee, if applicable, has not been received.

3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
   (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
   (b) ☐ No corrected drawings have been received.

4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. ☐ The reason(s) below:

MARY C

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Auto-Reply Facsimile Transmission

TO: Fax Sender at +9549251101

Fax Information
Date Received: 4/12/2005 11:56:46 AM [Eastern Daylight Time]
Total Pages: 13 (including cover page)

ADVISORY: This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received Cover Page =======>

A-3754

CERTIFICATION OF MAILING OR FAX TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

By: Yonghong Chen Date: April 12, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applic. No. : 10/612,352 Confirmation No. 3160
Applicant : Thomas Dera et al.
Filed : July 2, 2003
TC/A.U. : 3724
Examiner : Charles Goodman
Title: : Method and Device for Rotary Processing of Materials

Docket No. : A-3754
Customer No. : 24131

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT

S i r :

In response to the Office action dated January 13, 2005, please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 7 of this paper.

MEMORY TRANSMISSION REPORT

TIME :04-12-'05 12:07
TEL NO.1 :+9549251101
NAME :Lerner & Greenberg

FILE NO.	:	675
DATE	:	04.12 12:04
TO	:	PTO
DOCUMENT PAGES	:	13
START TIME	:	04.12 12:04
END TIME	:	04.12 12:07
PAGES SENT	:	13
STATUS	:	OK

TX ORIGINAL

A-3754

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By: Yongkang Chen Date: April 12, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applic. No.	:	10/612,352 Confirmation No. 3160
Applicant	:	Thomas Dera et al.
Filed	:	July 2, 2003
TC/A.U.	:	3724
Examiner	:	Charles Goodman
Title:	:	Method and Device for Rotary Processing of Materials
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Customer No.	:	24131

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT

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In response to the Office action dated January 12, 2005, please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 7 of this paper.

A-3754

CERTIFICATION OF MAILING OR FAX TRANSMISSION

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By: Yonghong Chen Date: April 12, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applic. No. : 10/612,352 Confirmation No. 3160

Applicant : Thomas Dera et al.

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Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT

S i r :

In response to the Office action dated January 12, 2005, please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 7 of this paper.

Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of claims:

Claim 1 (currently amended). A device for cutting side edges of sheet-form material for binding, comprising:

a tool body;

at least one cutting element fixed to the tool body, the at least one cutting element defining at least one cutting edge for cutting a leveled back and at least one notching segment for adding notches into the previously leveled back.

Claim 2 (original). The device of claim 1, wherein the notching segment is ground out of the cutting element.

Claim 3 (original). The device of claim 1, wherein the cutting edge is soldered to the tool body.

Claim 4 (original). The device of claim 1, comprising a plurality of the at least one cutting edges arranged along a circumference of the tool body and fixed thereto.

Claim 5 (original). The device of claim 1, comprising a cleaning brush integrated into the tool body.

Claim 6 (original). The device of claim 1, further comprising at least one additional notching element on a side of the cutting element opposite the at least one notching element.

Claim 7 (currently amended). A method of cutting side edges of sheet-form material for binding, comprising:

rotating a tool about an axis of rotation at an angle to a cutting plane, the tool having at least one cutting edge and at least one notching segment inside the cutting edge and projecting over the cutting plane; and[[,]]

cutting the sheet-form material with the at least one cutting edge along the cutting plane for cutting a leveled back and notching the sheet-form material with the notching segment for adding notches into the previously leveled back.

Claim 8 (original). The method of claim 7, wherein the notching segment extends a distance into the sheet-form material, and further comprising changing the distance by changing the angle.

Claim 9 (original). The method of claim 7, wherein the at least one notching segment notches the sheet-form material twice each pass, and the at least one cutting edge cuts the sheet-form material once each pass.

Claim 10 (original). The method of claim 7, comprising a plurality of cutting edges arranged along a circumference of the tool, and a plurality of notching segments inside the cutting edges.

Claim 11 (original). The method of claim 7, further comprising creating a vacuum by the rotation of the tool.

Claim 12 (currently amended). A method of making a device for cutting side edges of sheet-form material for binding, comprising:

forming, into at least one cutting element, a cutting edge for cutting a leveled back and a notching element for adding

notches into the previously leveled back ~~into at least one cutting element~~; and[[,]]

fixing the at least one cutting element to a tool body.

Claim 13 (currently amended). The method of claim 12, comprising:

forming the cutting edge and the notching element into the at least one cutting element; and[[,]]

subsequently fixing the at least one cutting element to the tool body.

Claim 14 (currently amended). The method of claim 12, comprising:

fixing the at least one cutting element to the tool body; and[[,]]

subsequently forming the cutting edge and the notching element into the at least one cutting element.

Claim 15 (currently amended). The method of claim 12, comprising a plurality of the at least one cutting elements;

wherein the fixing comprises soldering the plurality of the at least one cutting elements onto the tool body; and[[,]]

subsequently grinding the cutting edge and notching segment of each of the at least one cutting elements.

Claim 16 (original). The method of claim 12, comprising reforming the cutting edge and notching segment upon wear.

Claim 17 (original). The method of claim 16, wherein the reforming comprises grinding with a cutting level of the cutting element being ground off.

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-17 remain in the application. Claims 1, 7, and 12-15 have been amended.

In item 3 on page 2 of the above-mentioned Office action, claims 1-6 have been rejected as being anticipated by Okamura et al. (US 5,855,157) under 35 U.S.C. § 102(b).

In item 6 on page 3 of the above-mentioned Office action, claims 1-17 have been rejected as being unpatentable over Blake (US 3,758,928) in view of Okamura et al. under 35 U.S.C. § 103(a).

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references. However, the language of the claims has been amended in an effort to even more clearly define the invention of the instant application.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for:

> A device for cutting side edges of sheet-form material for binding, comprising:
>
> a tool body;
>
> at least one cutting element fixed to the tool body, the at least one cutting element defining at least one cutting edge for cutting a leveled back and at least one notching segment for adding notches into the previously leveled back.

Claim 7 calls for:

> A method of cutting side edges of sheet-form material for binding, comprising:
>
> rotating a tool about an axis of rotation at an angle to a cutting plane, the tool having at least one cutting edge and at least one notching segment inside the cutting edge and projecting over the cutting plane; and
>
> cutting the sheet-form material with the at least one cutting edge along the cutting plane for cutting a leveled back and notching the sheet-form material with the notching segment for adding notches into the previously leveled back.

Claim 12 calls for:

> A method of making a device for cutting side edges of sheet-form material for binding, comprising:
>
> forming, into at least one cutting element, a cutting edge for cutting a leveled back and a notching element for adding notches into the previously leveled back; and
>
> fixing the at least one cutting element to a tool body.

As admitted by the Examiner, Blake does not disclose a cutting element having both a cutting edge and a notching segment.

In the technical field of binding books, the terms "cutting" and "notching" are well known. Especially when binding by the application of glue to the sheets, the preparation of the material is performed in two distinct steps. The first step is cutting the material and the second step is notching the material. In book binding, the cutting is performed to level the back of books prior to gluing and the notching is performed to add notches into the previously leveled back of the book to enhance the quality of gluing since the glue can get into the notches.

The steps cannot be reversed, i.e. first notching and then cutting, because the cutting would remove the notches and thus render the notching useless, namely a leveled back would result and the advantage of the notches would be lost.

Okamura et al. teach a saw blade. Although a saw blade seems to be equivalent to a cutting device, it is not in the sense of the invention of the instant application. A saw blade is used for cutting something in two, whereas the cutting device of the invention of the instant application, like a mill, is used to level something. A saw blade is not a mill. Both saw blade and mill rotate and also move in a linear fashion with regard to the work piece. The main difference is that the saw

blade removes material on the outside of its circumference with a fixed thickness (e.g. the thickness of the saw blade) between two parts of the material to be separated by the saw blade, whereas the mill removes material up to a certain width from one side of the material. It is impossible to separate the material into two parts with a mill.

Okamura et al. teach a saw blade with cutting teeth and biting teeth. However, Okamura et al.'s biting teeth, which might be on top of the cutting teeth as can be seen in Figs. 11-13, Fig. 20, and Fig. 37, are, due to their location, restricted to bite into material that will be entirely removed afterwards by the cutting teeth, so that no trace of the bite of the biting teeth remains when the cutting is completed. This is the exact opposite of the invention of the instant application.

Also, it has to be noted that despite the existence of biting and cutting teeth in the disclosure of Okamura et al., the biting and cutting are not two distinct processes in a way that two results are achieved. Okamura et al.'s only <u>one result</u> is a clear cut, which is performed in two steps: biting and then cutting. In contrast, the invention of the instant application achieves <u>two distinct results</u>, namely a leveled surface due to the cutting and notches in the material due to

the notching. Thus, Okamura et al. do not disclose a dual functionality (clean cut and notches as in the invention of the instant application), but only a single functionality (clean cut) performed in two steps (biting and cutting).

Okamura et al. actually teach away from the invention of the instant application. This is evident from the very problem that is addressed and shall be overcome by Okamura et al.'s saw blade, namely *"that "fluffs" or "returns" are caused to occur upon cutting of wood or the like so that cut surfaces of the wood could not be fine"* (see *column* 1, lines 14 to 17) and "*The present invention has been suggested in view of the foregoing problem of conventional saw blade, and is to provide a saw blade which can prevent any "fluff" and "return" from occurring so as to render the finishing work unnecessary, prevent any clogging of the cutting path from occurring with chips discharged from the path in smooth manner and with a chip-receiving capacity increased, render any finishing work of side surfaces of the cut path unnecessary, and allow required cutting power to be minimized*" (see column 1, lines 50 to 59).

It is clear that the intention of the invention of the instant application is to create a cut and notched surface, which is the opposite of the smooth surface created by Okamura et al.

In short, Okamura et al. do not teach the feature "notching" which has to be understood with the feature of "for binding" from the claims of the instant application, and the dual functionality as claimed in the invention of the instant application is also absent in the teaching of Okamura et al.

As has been discussed above, Okamura et al. do not disclose cutting and notching, because there are no notches after the cut, but teach biting and cutting, the two steps having the same functionality, namely creating a smooth surface after the cutting as opposed to a dual functionality namely a level surface and notches in the level surface as in the invention of the instant application.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1, 7, and 12. Claims 1, 7, and 12 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claims 1, 7, or 12, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-17 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made. Please charge any fees which might be due with respect to 37 CFR Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

Yonghong Chen
Reg. No. 56,150

Yonghong Chen

For Applicants

YC

April 12, 2005

Lerner and Greenberg, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101

DOCKET NO.	INVENTOR	Amend (No. of Pgs.) Amend. re. Drawing Chngs Amend 1.116 (No. of Pgs.) Appeal	Application (No. of Pgs.)	Application Data Sheet	Assignment	Brief	Cert. Correction	CIP	Claim for Priority	Declaration	Divisonal	Express	§ 371	Fil. Rcpt. Correct.	Formal Drawings (No.)	IDS (No. of Refs.)	Issue/Pub. Fees	Letter	Letter Draftsman	Maintenance Fee	PCT Cover Sheet	Petition for Ext.	Power of Attorney	Priority Document	RCE	Response	Trademark Application	1533	$ Amount	$ Amount	Credit Card	Check	Addit. Info.
12-Apr-05																																
GR99P1912	Reisinger	13																														Faxed
A-3754	Dera	13																														Faxed
D-3790D	Schneider															X	X											$800.00		X		85(b), Cl fPrio (Copy)
WRA-33270	Masina															X												$1,000.00		X		85(b), Pub Fee
S&ZIO020403	Marx	19																														
P2001,0104	Janke					8																						$500.00		X		Appndx(2)
W&B-INF-1182	Bucksch				X											X												$1,700.00	$40.00	X		85(b), Pub. Fee, 1595
GR99P3500	Mattejat				X											X												$1,700.00	$40.00	X		85(b), Pub. Fee, 1595
W&B-INF-1947	Felber				X											X												$1,700.00	$40.00	X		85(b), Pub. Fee, 1595
HAF-0363	Schüttinger																	X														Inter. Prel Exam. Rep.
A-4128	Förch									X								X														
A-3580	Elkotbi															4																1449, EP Search Rep.
EPH-80483	Hoenzelaer															3																1449
J&R-0819	Mayer	13																										$200.00		X		Faxed
WMP-IFT-943	Deboy	12																														Faxed
Mp.Nr.00/616	Greulich	3													8			X														
L&L-I0075	Hartmann																					1	X					$910.00		X		